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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,485	01/21/1999	SHUJI OTSUKA	102624	6019

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/234,485

Applicant(s)

OTSUKA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 14-20 is/are rejected.
- 7) ☒ Claim(s) 2,3,5 and 7-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/02 has been entered.

Response to Amendment

2. Applicant's amendment received on 11/18/02, has been entered and made of record. Currently, **claims 1-3, 5, and 7-20** are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1 and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. **Claims 1 and 18** both recite the limitation "displaying the addressee identification information fetched out of the computer" in lines 8 and 9. There is insufficient antecedent basis for this limitation in the claim, since only data of addressee identification that is stored in the

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computer side is introduced in lines 6 and 7, which is subsequently used for antecedent for the additional display of the addressee identification information recited in lines 9 and 10 of the claim. The examiner suggests amending the limitation to read “displaying addressee identification information fetched out of the computer”.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. **Claim 14-17, 19, and 20** are rejected under 35 U.S.C. 102(e) as being anticipated by Rachelson (U.S. Patent Number 6,157,706, cited in the Office action dated 6/17/02).

Regarding **claim 14**, Rachelson discloses an internet facsimile machine (facsimile machine 110) capable of executing facsimile transmission via an internet to an addressee (see abstract) using a computer (administrative site 100) installed with an application program for

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execution of internet facsimile transmission (column 6, line 36 through column 7, line 25), comprising analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation (see Fig. 5, and column 7, line 60 through column 8, line 48), reading means for reading the data of address information analyzed by the analyzing means (column 7, lines 6 through 67, and column 11, lines 10 through 29), and format converting means for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission (column 11, lines 5 through 37), wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer (column 10, lines 32 through 39).

Regarding *claim 15*, Rachelson discloses the facsimile machine discussed above in claim 14, and further teaches of means (address book, column 8, lines 3 through 48) for storing the data of address information converted by the format converting means as an addressee address for the facsimile transmission via the internet (column 8, lines 4 through 14, and column 11, lines 5 through 20) and address selecting means for selecting a desired address from the address information storage means (column 8, lines 4 through 48, and column 11, lines 5 through 20).

Regarding *claim 16*, Rachelson discloses the facsimile machine discussed above in claim 14, and further teaches that the electronic mail application program is in operation on the computer installed with the application program for execution of internet facsimile transmission (column 10, line 32 through column 11, line 37) or a computer other than the computer installed with the application program for execution of internet facsimile transmission.

Regarding **claim 17**, Rachelson discloses the facsimile machine discussed above in claim 15, and further teaches that the electronic mail application program is in operation on the computer installed with the application program for execution of internet facsimile transmission (column 10, line 32 through column 11, line 37) or a computer other than the computer installed with the application program for execution of internet facsimile transmission.

Regarding **claim 19**, Rachelson discloses an internet facsimile machine (facsimile machine 110) capable of executing facsimile transmission via an internet to an addressee (see abstract) using a computer (administrative site 100) installed with an application program for execution of internet facsimile transmission (column 6, line 36 through column 7, line 25), comprising an analyzing circuit for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation (see Fig. 5, and column 7, line 60 through column 8, line 48), a reading circuit for reading the data of address information analyzed by the analyzing circuit (column 7, lines 6 through 67, and column 11, lines 10 through 29), and a format converting circuit for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission (column 11, lines 5 through 37), wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer (column 10, lines 32 through 39).

Regarding **claim 20**, Rachelson discloses a recording medium (memory 304, column 6, lines 7 through 27, seen in Figs. 1-3) for recording a program for operating a facsimile machine (facsimile machine 110) using a computer (administrative site 100) installed with an application

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program for execution of internet facsimile transmission (see abstract, and column 6, line 36 through column 7, line 25), with the program realizing the functions of analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic application program which is already in operation (see Fig. 5, and column 7, line 60 through column 8, line 48), reading means for reading the data of address information analyzed by the analyzing means (column 7, lines 6 through 67, and column 11, lines 10 through 29), and format converting means for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission (column 11, lines 5 through 37), wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer (column 10, lines 32 through 39).

Allowable Subject Matter

8. **Claims 1-3, 5, 7-13, and 18**, specifically independent **claims 1 and 18**, would be allowable if rewritten to overcome the rejection noted above under 35 U.S.C. 112. Subsequently, **claims 2, 3, 5, and 7-13** are objected to as being dependent upon a rejected base claim.

9. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claims 1 and 18**, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the system, as claimed include a means or circuit, provided at the computer side for displaying the addressee identification information fetched out of the computer as well as the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of

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addressee identification information is selected. The closest prior art, Houghton *et al.* (U.S. Patent Number 6,009,153), Feder (U.S. Patent Number 5,872,845), and Rachelson (U.S. Patent Number 6,157,706), each fail to specifically teach of displaying, at the computer side, the addressee identification information fetched out of the computer as well as the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of addressee identification information is selected. This limitation, which was added in the amendment dated 11/18/02, renders the claims allowable.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
March 7, 2003

MADELEINE NGUYEN
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PATENT EXAMINER

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